REMARKS

Entry of the foregoing amendments to the application is requested on the grounds that the claims, as amended, patentably distinguish over the cited art of record or, alternatively, place the application in better condition for appeal. The claims more particularly point out and distinctly claim the subject matter which Applicant regards as the invention. No new issues have been added which would require further consideration and/or search, nor has any new matter been added. The claims as amended are believed to avoid the rejections applied in the Final Office Action for reasons set forth more fully below.

The Final Office Action of January 22, 2010, has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection and objection are traversed and overcome. Upon entry of this Amendment, claims 16-35 remain in the application. New claims 36 and 37 have been added herein. It is submitted that these claims are fully supported by the application as filed, at least at page 4, lines 12-13 and page 8, lines 24-29. Reconsideration of the claims is respectfully requested.

Claims 16, 18, 20-24, 26, and 31-35 stand objected to because of informalities relating to modifiers of the word "pattern". Although Applicant does not acquiesce to the objections, claims 16, 18, 20-24, 26, and 31-35 have been revised to obviate the objections. Claims 29 and 30 were revised for similar informalities, although no objection was noted by the Examiner.

Claims 18, 20, and 25 stand objected to because the claims refer to a step of modifying, however in claim 16 (from which claims 18, 20 and 25 ultimately depend), there is no step of modifying. Applicant has revised claims 18, 20 and 25 to refer to "the step of generating from the first document the second document…."

As such, it is submitted that the objections have been obviated and overcome.

Claims 19 and 25 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Examiner cites insufficient antecedent basis for "the printer driver" in line 1 of claim 19. Claim 19 has

been revised to recite "a printer driver," thereby obviating the rejection. The Examiner further states that "the area" in line 3 of claim 25 is an unclear reference. Applicant has revised claim 25 to recite that the area is the functional area. As such, it is submitted that the 112, second paragraph has been obviated.

Claims 16, 17, and 21-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Patent No. 6,987,573) in view of Lapstun (U.S. Patent No. 7,070,098). The Examiner states that Silverbrook's printing of visible information and coded data teaches providing a first document for printing, the first document comprising at least one functional area wherein pattern markings are to be printed as recited in Applicant's claims.

Applicant respectfully submits that Applicant's pattern markings are distinct from Silverbrook's coded data. In a preferred embodiment, Silverbrook's coded data includes at least one tag, each tag being indicative of the identity of the region (see Col. 2, lines 23-25). The coded data 3 is printed as a collection of tags 4 using invisible ink (see Col. 5, lines 22-23). The tags are arranged within a tessellated pattern comprising a plurality of tiles, each of the tiles containing a plurality of the tags (see Claim 18). A tag map 811 describes the tag tiling scheme (see Col. 14, line 40). The tag map maps each tag ID in a tagged region to a corresponding location (see Col. 11 lines 25-27). The tags preferably tile the entire page (see Col 8, lines 22-23). It is submitted that the tag tiling pattern disclosed by Silverbrook is constructed of complex symbols. The smaller these symbols are made, the more difficult it is to produce the patterned writing surface, and the greater the risk of incorrect position determinations, while the larger the symbols are made, the poorer the position resolution becomes.

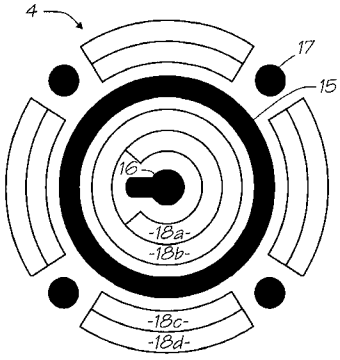
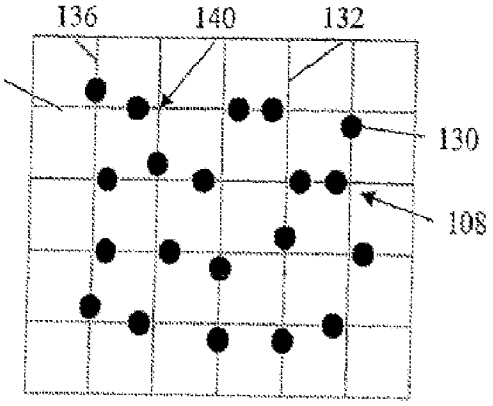


FIG. 5

Silverbrook's Tag



Applicant's Fig. 2 portion of position-identifying pattern

In sharp contrast, Applicant's pattern markings are not tags. As used by Applicant, "pattern" refers to position-identifying background markings printed on some parts of a carrier (see Page 8, lines 24-29 in the instant application as filed). The markings may be dots, arranged in a position-identifying systematic pattern of offsets from, for example, intersections of an imaginary grid (see Applicant's Fig. 2 reproduced above for convenience). The pattern is configured such that any group of a sufficient number of dots, for example any group of 36 dots arranged in a six by six square, will be unique within the pattern space (see Page 9, lines 8-17 of the application as filed). Other suitable position-identifying patterns were described by reference in page 9, lines 18-20 of the Application as filed. It is submitted that one skilled in the art would recognize that Silverbrook's concentric symbol tags would not be considered suitable for a position-identifying pattern such as that described in the description and examples provided in Applicant's disclosure.

Silverbrook's tags convey no absolute location information without reference to a map maintained in a computer system (see Col. 4, lines 49-53, Silverbrook). In sharp contrast, Applicant's pattern markings convey a location in pattern space. Furthermore, unlike Silverbrook's tags, each specific part of Applicant's position-coding pattern also contributes to the coding of adjacent positions (see WO 00/73983, page 4 (attached

hereto as Exhibit 1), lines 32-34, referenced in the Application as filed at page 9, line 20).

As noted by the Examiner, Silverbrook fails to teach "wherein at least one of the shape or location of the at least one functional area is modified." The Examiner states that "[Lapstun] '098 does teach generating from the first document a second document wherein at least one of the shape or location of the at least one functional area is modified (Column 3, lines 49-54 and Column 62, lines 17-29). Applicant respectfully points out that the cited references in Lapstun disclose encoding and printing tags in landscape and portrait orientation, however, Lapstun is **silent** on modifying the shape or location of the at least one functional area.

Furthermore, because Silverbrook did not teach "wherein at least one of the shape or location of the at least one functional area is modified," Silverbrook could not have anticipated "obtaining a portion of a pattern to fit the modified functional area" as recited in independent claim 16 by Applicant.

Applicant respectfully submits that the Examiner is using impermissible hindsight from Applicant's disclosure in order to assume that Silverbrook in view of Lapstun teaches or even suggests that at least one of the shape or location of the at least one functional area is modified.

The Federal Circuit has spoken to the issue of impermissible hindsight on numerous occasions. In In re David H. Fine, 837 F.2d 1071, 5 U.S.P.Q. (BNA) 1596 (Fed. Cir. 1988), the court stated:

> To reach a proper conclusion under § 103, the decisionmaker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of all the evidence, the decisionmaker must then determine whether . . . the claimed invention as a whole would have been obvious at that time to that person. 35 U.S.C. § 103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts. (emphasis in original) Id. at 1073-74, quoting Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566 (Fed. Cir. 1987)

The Fine court makes it clear that the Examiner must "step backward in time" to just before the present invention was made, and look at Silverbrook in view of Lapstun without knowledge gleaned from Applicant's disclosure. If the Examiner did this, in light of the detailed discussion above of what the skilled artisan would glean from the reference, the Examiner would come to the conclusion that the references do not speak to the issue of the shape or location of the functional area being modified at all.

As such, it is submitted that Applicant's invention as recited in claims 16, 26 and 35, as well as in the claims depending therefrom, is not anticipated, taught or rendered obvious by Silverbrook or Lapstun, either alone or in combination, and patentably defines over the art of record.

Claims 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Lapstun, and further in view of Natori (U.S. Publication No. 2002/0175958). The Examiner states that Silverbrook in view of Lapstun does not teach wherein the step of modifying the document or obtaining the portion of pattern for the functional area is performed by a print application. According to the Examiner, Natori does teach wherein the step of modifying the document or obtaining the portion of pattern for the functional area is performed by a print application (Page 2, paragraph 20 and Page 5, paragraph 61).

Applicant respectfully submits that Natori does not teach a functional area of a document at all, because Natori is not concerned with printing digital documents as disclosed by Applicant. Rather, Natori is drawn to printing a page of a document over multiple sheets (see Natori Abstract). Natori prints visible patterns on a sheet to assist physically cutting and pasting the sheets together to form a composite page larger than a single sheet of paper (see Natori Fig. 4). It is submitted that Natori fails to disclose modifying at least one of the shape or location of the at least one functional area (included by dependency from claim 16). Natori also fails to disclose obtaining a portion of a pattern to fit the modified functional area.

Therefore, it is submitted that Applicant's invention as recited in claims 18-20 is not anticipated, taught or rendered obvious by Silverbrook, Lapstun, or Natori, either alone or in combination, and patentably defines over the art of record.

For all the reasons stated above, it is submitted that Applicant's invention as defined in independent claims 16, 26, and 35 as well as in those claims depending therefrom, is not anticipated, taught or rendered obvious by the cited references, and patentably defines over the art of record.

It is submitted that the absence of a reply to a specific rejection, issue or comment in the instant Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this Amendment should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this Amendment, and the amendment of any claim does not signify concession of unpatentability of the claim prior to its amendment.

In summary, claims 16-35 remain in the application, and new claims 36 and 37 have been added herein. It is submitted that, through this Amendment, Applicant's invention as set forth in these claims is now in a condition suitable for allowance. Should the Examiner believe otherwise, it is submitted that the claims as amended qualify for entry as placing the application in better form for appeal.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

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